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REMARKS

Claims 1-27 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

Applicant notes that previously pending claim 17 and has only been rewritten into independent form and has not been amended to add any further limitations. As discussed in more detail below, Applicant submits that the rejection of claim 17 is improper and should be withdrawn.

Claims 1, 3, 7, 19 and 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,237,490 to Ferng. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully asserts that the Examiner has not yet met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

Claim 1 defines a lighting device comprising a housing, a first light emitting diode located on the housing, a second light emitting diode located on the housing and spaced from the first light emitting diode, a first magnifier lens arranged in a light path of the first light emitting diode for focusing a first light beam onto a target area, a second magnifier lens arranged in a light path of the second light emitting diode for focusing a second light beam onto the target area such that the first light beam and the second light beam overlap on the target area, a support member for supporting the first and second magnifier lenses relative to the first and second light emitting diodes, respectively and a rear housing coupled to a back side of the housing, the rear housing having a battery compartment.

The prior art of record does not disclose the above noted features of claim 1. Specifically, the Ferng '490 patent does not disclose a first magnifier lens arranged in a light path of a first light emitting diode for focusing a first light beam onto a target area and a second magnifier lens arranged in a light path of a second light emitting diode for focusing a

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second light beam onto the target area such that the first light beam and the second light beam overlap on the target area, along with the remaining features of claim 1. Notably, the Ferng '490 patent does not disclose that light beams emitted from two LEDs 42 are focused after passing through any magnifier lenses such that a first light beam and a second light beam overlap on a target area. Accordingly, claim 1 is in condition for allowance over the Ferng '490 patent. Furthermore, claims 3-7 depend from claim 1, and since claim 1 is patentable over the Ferng '490 patent, claims 3-7 are patentable over the Ferng '490 patent.

Claim 19 comprises a lighting device comprising a front housing having a front side and a back side, a plurality of light emitting diodes located on the front housing, the plurality of light emitting diodes emitting light from the front side of the front housing, a plurality of lenses arranged in front of the plurality of light emitting diodes and a rear housing coupled to the back side of the front housing, the rear housing having a battery compartment.

The prior art of record does not disclose the above noted features of claim 19. Specifically, the Ferng '490 patent does not disclose a front housing having a front side and a back side, with a plurality of light emitting diodes located on the front housing and emitting light from the front side of a front housing, and a rear housing coupled to the back side of the front housing, with the rear housing having a battery compartment, along with the remaining features of claim 19. Specifically, the Ferng '490 patent does not disclose a front housing that emits light from a front side of the front housing and having a rear housing coupled to a back side of the front housing. Accordingly, claim 19 is patentable over the Ferng '490 patent. Furthermore, claim 20 depends from claim 19, and since claim 19 is patentable over the Ferng '490 patent, claim 20 is patentable over the Ferng '490 patent.

Claims 1-16, 19 and 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,580,156 to Suzuki et al. The standard for rejecting a claim as being anticipated by the prior art and the subject matter of claims 1 and 19 are discussed above.

The prior art of record does not disclose or suggest the above noted features of claim 1. Specifically, the Suzuki et al. '156 patent does not disclose a first magnifier lens arranged in a light path of a first light emitting diode for focusing a first light beam onto a target area and a

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second magnifier lens arranged in a light path of a second emitting diode for focusing a second light beam onto the target area such that the first light beam and the second light beam overlap on the target area along with the remaining features of claim 1. Specifically, as noted in Fig. 6 of the Suzuki et al. '156 patent, any light leaving the light condensing step 31 would be parallel with light leaving another light condensing step 31. Accordingly, any light leaving two light condenser steps 31 would not overlap. Accordingly, claim 1 is in condition for allowance. Furthermore, claims 2-9 depend from claim 1, and since claim 1 defines unobvious patentable subject matter as discussed above, claims 2-9 define patentable subject matter.

Applicant further notes that claim 8 is not for an intended use, but an actual use.

Claim 10 defines a lighting device comprising a housing, a first light emitting diode located on the housing, a second light emitting diode located on the housing and spaced from the first light emitting diode, a first magnifier lens comprising a convex surface and arranged in a light path of the first light emitting diode for focusing a first light beam onto a target area, a second magnifier lens comprising a convex surface and arranged in a light path of the second light emitting diode for focusing a second light beam onto the target area such that the first light beam and the second light beam overlap on the target area, wherein the second magnifier lens is spaced from the first magnifier lens, a cover disposed over a front of the housing, said cover supporting the first and second magnifier lenses relative to the first and second light emitting diodes, respectively and a rear housing coupled to a back side of the housing and the rear housing having a battery compartment.

The prior art of record does not disclose the above-noted features of claim 10. Specifically, the prior art of record does not disclose a first magnifier lens comprising a convex surface and arranged in a light path of a first light-emitting diode for focusing a first light beam onto a target area and a second magnifier lens comprising a convex surface and arranged in a light path of a second light emitting diode for focusing a second light beam onto the target area such that the first light beam and the second light beam overlap on the target area, along with the remaining features of claim 10. As discussed above in regard to claim 1, any light leaving two light condensing steps 31 in the Suzuki et al. '156 patent would be parallel such that they would not overlap on a target area. Accordingly, claim 10 is in condition for allowance.

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Furthermore, claims 11-16 depend from claim 10, and since claim 10 defines patentable subject matter as discussed above, claims 11-16 define patentable subject matter.

The prior art of record does not disclose the above noted features of claim 19.

Specifically, the Suzuki et al. '156 patent does not disclose a front housing having a front side and a back side, with a plurality of light-emitting diodes on the front housing and emitting light from the front side of the housing, and a rear housing coupled to the back side of the front housing, with the rear housing having a battery compartment, along with the remaining features of claim 19. The Suzuki et al. '156 patent does not include any rear housing on a back side of a front housing and light emitting diodes emitting light from a front side of a front housing. Accordingly, claim 19 is in condition for allowance. Furthermore, claim 20 depends from claim 19, and since claim 19 defines unobvious patentable subject matter as discussed above, claim 20 defines patentable subject matter.

Claim 17 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Suzuki et al. '156 patent in view of U.S. Patent No. 4,797,793 to Fields.

As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness. Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention. With respect to the TSM test, the U.S. Patent and Trademark Office, which had adopted that test, set forth the requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

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The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [emphasis added]

The U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, one element to the finding of a *prima facie* case of obviousness is common to both the TSM standard and the standards that may otherwise fall within the per view of the KSR decision. Specifically, each and every element of the claimed invention must still be found in the prior art. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

Further, with respect to the recent Supreme Court decision in *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), the Deputy Commissioner for Patent Operations has issued a memo advising the examiners that "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

Claim 17 as currently presented is identical as previously presented and has only been rewritten into independent form. Claim 17 defines a lighting device comprising a housing, a first light emitting diode located on the housing, a second light emitting diode located on the housing and spaced from the first light emitting diode, a first magnifier lens arranged in a light path of the first light emitting diode for focusing a first light beam onto a target area, a second magnifier lens arranged in a light path of the second light emitting diode for focusing a second light beam onto the target area, a support member for supporting the first and second magnifier lenses relative to the first and second light emitting diodes, respectively, a rear housing coupled to a back side of the housing, the rear housing having a battery compartment and a headband strap.

Applicant submits that claim 17 is not obvious over the cited art of record. The Suzuki et al. '156 patent discloses a traffic marker to be disposed on a road boundary such as a shoulder of the road. See lines 6-21 of column 1 and lines 13-18 of column 2. The Fields

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'793 patent discloses a headband for holding a flashlight. According to the Office Action, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the headband strap as shown in Fields for the portable lighting apparatus of Suzuki et al., for the purpose of providing a hand free holding mechanism for the lighting apparatus, which may increase the safety/performance of the user." However, Applicant submits that it would have not been obvious to take a marker for a road boundary and place it on a head of a person. Since the markers of the Suzuki et al. '156 patent are meant to be placed on the side of a road and not used in a hand of a person, it is not obvious to make these markers into a hand free holding mechanism. Applicant submits that it is simply not obvious to place a stationary road marker on a person's head. Accordingly, Applicant submits that claim 17 is in condition for allowance.

Claim 18 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Suzuki et al. '156 patent in view of U.S. Patent No. 6,012,824 to Sharrah et al. Claim 18 depends from claim 1, and since claim 1 defines unobvious patentable subject matter as discussed above, claim 18 defines patentable subject matter.

Applicant submits that new claims 21-27 define patentable subject matter and further are in condition for allowance.

All pending claims 1-27 are in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date

  
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